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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,877	05/23/2001	Takaaki Amano	100809-16253 (SCET 18,699	9471
7590 06/24/2005 KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK,, NY 10022-2585			EXAMINER JANVIER, JEAN D	
			ART UNIT 3622	PAPER NUMBER
DATE MAILED: 06/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,877

Applicant(s)

AMANO ET AL.

Examiner

Jean Janvier

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date ____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
|---|---|

Response To Applicant's Amendments

The Examiner approves the new title of the invention, the new abstract of the disclosure, the changes made to the specification and to the claims.

Response to Applicant's Arguments

In general, Applicant argues that Goldhaber teaches that compensation is received only once for the same advertisement, while in the present invention as now claimed (amended), compensation may be received for the same ad multiply. However, the argued limitations are not necessarily claimed and the Examiner does not read limitations from the specification into the claimed invention.

Further, in the limitations "said rule being **that while a point degree owned by a customer increases, a point degree to be displayed decreases**", although it is understood that points or digital cash owned or accumulated by the user increases overtime as the user reads more displayed advertisements, however, it is unclear what "point degree to be displayed", with respect to the same user who points increase overtime, comes to decrease and under what circumstances or conditions.

Here, in response to the previous 112 (2) rejection of claim 3, the Applicant had canceled claim 3 and incorporated its questionable claim language, as herein explained, into the independent claims. Such response is deemed inadequate since it fails to provide a solution to the current problem. **Thus, the Applicant's arguments are not persuasive and this Action has been made final.**

Art Unit: 3622

Detailed Action

Specification

Status of the claims

Claims 2 and 3 are canceled and claims 1, 4-9 and newly added claim 10 are currently pending in the Instant Application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-10 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning claims 8-10, “said display point degree determining means...” lacks proper antecedent basis and such claim language also renders the claims indefinite for the phrase “determining means”, as recited therein, or **means plus function type claim** is more appropriate for system and apparatus-type claim and not for method-step or process type claim.

Art Unit: 3622

Further, independent claims 1, 5, 8, 9 and 10 (including their dependent claims) recite the limitations "said rule being **that while a point degree owned by a customer increases, a point degree to be displayed decreases**". Here, the claim omits essential elements so as to enable one skilled in the art to understand or practice the invention. Additionally, the metes and bounds of the claims are not clearly defined. Although it is understood that points or digital cash owned or accumulated by the user increases overtime as the user reads more displayed advertisements, however, it is unclear what "point degree to be displayed", with respect to the same user who points increase overtime, comes to decrease and under what circumstances or conditions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-10 are rejected under 35 USC 102(b) as being anticipated by Golhaber, US Patent 5, 794, 210

As per claims 1 and 4-10, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to others, in accordance with their interest profile 124 (targeted advertisements). The advertiser 62 provides

Art Unit: 3622

or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 (Internet) and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad matching, the user's computer 104 or the software agent 110 retrieves the full text and/or graphics corresponding to the matched advertisement 68. In other words, the software agent 110

Art Unit: 3622

maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110 may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads, associated with a plurality of advertisers, and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, showing a related dollar figure, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin (displaying a point degree in combination with an advertisement from an advertisement owner or advertiser).

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Further, Goldhaber discloses a method of and system for brokering and selling the attention of a customer wherein, among other things, advertisers pay or compensate the customer for the opportunity to have their ads read by the customer or subscriber of the system. By clicking on a Cybercoin button (or banner, ad box or link) or selectable object, displayed on the customer's PC 104 and representative of an ad, the customer indicates his intention to read the

Art Unit: 3622

said ad and once the system verifies, through a quiz process, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full human attention or interaction, the customer is compensated in the form of credits or digital cash (points) for paying attention to the ad. **Here, the value of the credits or digital cash (displayed points degree) is equal to the amount shown on the Cybercoin. As time goes by, the customer accumulates a certain amount of credits or digital cash (points balance) for reading a plurality of targeted ads from a plurality of advertisers, wherein the credits balance or digital cash balance (points total) is stored in a database or customer's digital cash repository 126 and the customer's digital cash repository or the customer's account storing the customer's credits is debited for the customer's use or ordering of information unit, medical report, service, goods, movies, etc (redemption of credits or digital cash).**

In addition, Goldhaber discloses a system wherein one or more ad titles or thumbnails are displayed on the customer's terminal along with one or more respective selectable objects or Cybercoins showing the associated monetary amount that the customer will earn if he activates a particular selectable object to read the corresponding advertisement (full version of the ad).

(Col. 16: 6-64; fig. 12; col. 7: 48-61; col. 11: 32-38) and (Col. 4: 47-63; Col. 19: 56-67; figs. 10-11).

Furthermore, Goldhaber discloses a system wherein advertisers pay users to view their advertising messages in accordance with the user's profile matching the advertisers' criteria or specifications (advertiser's rule to determine a point degree or monetary value of a displayed Cybercoin related to an ad). For example, if a user provides no profile data to an interesting advertiser, then the point degree or the monetary value shown on a displayed Cybercoin, related

Art Unit: 3622

to an advertisement from an advertiser, is less significant. On the other hand, if the user makes his profile available to the interesting advertiser, who uses the profile information to tailor his ads to the user, then the displayed point degree or monetary value related to the displayed Cybercoin corresponding to the advertisement from the advertiser is more significant (col. 14: 5-10). In another embodiment, the point degree or the monetary value related to a displayed Cybercoin corresponding to an ad from an advertiser is determined based on the highest bid amount offered by an interesting advertiser from a plurality of advertisers for the opportunity to present at least one ad to a targeted user, wherein the bidding process may be silent (passive) or active (advertiser's criteria to determine a point degree...-col. 4: 32-64).

Finally, Goldhaber discloses a system wherein once a user has successfully activated a displayed Cybercoin and adequately read or interacted with the associated advertisement, then the user's digital cash repository 126 is updated or increased accordingly and the displayed Cybercoin is deactivated (or its value is now equal or decreased to zero) to prevent the user from repeatedly clicking on the Cybercoin in the future to read the same advertisement and being compensated for such actions (fig. 12; col. 17: 33-63). It is further recognized that the displayed Cybercoin 62 (selectable object or banner) may be replaced with a coupon icon 63, which performs similar functions (sort or type of point degree or Cybercoin 62 or coupon icon 63 monetary value or amount-col. 18: 13-33).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3622

US Patent %, 724, 521 to Dedrick discloses a system for storing a user's profile information, including user's interaction with displayed electronic content and/or advertisements, on the user's computer wherein no outside third party has access to the user's stored profile information.

US Patent 5, 974, 398 to Hanson discloses an interactive information and entertainment service customers see advertisers' bids for their attention which are displayed on their display screens and choose which advertisements to view. For each advertisement viewed, the advertisers' bid amount would pay for a portion of the user's service or usage charge. A display on the user's terminal screen includes the advertisers most willing to pay for the user's attention and the dollar amount bid. If the user chooses to see a particular advertiser's message, then the user is reimbursed, or a credit is applied to the user's service account for the amount of the bid promised by the advertiser whose message was viewed. Customer interest profiles and service usage data collected by the service provider are used to identify particular user characteristics to advertisers. Advertisers define user characteristics of particular desirability and place a dollar value on having messages viewed by individual users based on the desirability of the user (See abstract; figs. 4-5).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

06/17/05

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

**JEAN D. JANVIER
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Jean D. Janvier", is written over a rectangular stamp that contains the text "JEAN D. JANVIER" and "PRIMARY EXAMINER".